1   MORRISON & FOERSTER LLP
    MICHAEL A. JACOBS (Bar No. 111664)
2   mjacobs@mofo.com
    MARC DAVID PETERS (Bar No. 211725)
3   mdpeters@mofo.com
    DANIEL P. MUINO (Bar No. 209624)
4   dmuino@mofo.com
    755 Page Mill Road, Palo Alto, CA 94304-1018
5   Telephone: (650) 813-5600 / Facsimile: (650) 494-0792

6   BOIES, SCHILLER & FLEXNER LLP
    DAVID BOIES (Admitted *Pro Hac Vice*)
7   dboies@bsfllp.com
    333 Main Street, Armonk, NY 10504
8   Telephone: (914) 749-8200 / Facsimile: (914) 749-8300
    STEVEN C. HOLTZMAN (Bar No. 144177)
9   sholtzman@bsfllp.com
    1999 Harrison St., Suite 900, Oakland, CA 94612
10 Telephone: (510) 874-1000 / Facsimile: (510) 874-1460

11 ORACLE CORPORATION
    DORIAN DALEY (Bar No. 129049)
12 dorian.daley@oracle.com
    DEBORAH K. MILLER (Bar No. 95527)
13 deborah.miller@oracle.com
    MATTHEW M. SARBORARIA (Bar No. 211600)
14 matthew.sarboraria@oracle.com
    500 Oracle Parkway, Redwood City, CA 94065
15 Telephone: (650) 506-5200 / Facsimile: (650) 506-7114

16 *Attorneys for Plaintiff*
    ORACLE AMERICA, INC.
17

18   UNITED STATES DISTRICT COURT

19   NORTHERN DISTRICT OF CALIFORNIA

20   SAN FRANCISCO DIVISION

21 ORACLE AMERICA, INC.   Case No. CV 10-03561 WHA

22   Plaintiff,   **ORACLE AMERICA, INC.'S**
                                             OPPOSITION TO GOOGLE'S
23   v.   **MOTION *IN LIMINE* NO. 5 TO**
                                             EXCLUDE EVIDENCE OBTAINED
24 GOOGLE INC.   **FROM MOTOROLA MOBILITY,**
                                             INC.
25   Defendant.

26   Dept.: Courtroom 8, 19th Floor
                                             Judge: Honorable William H. Alsup
27

28

1   During fact discovery, Oracle obtained testimony and documents from Motorola Mobility,

2   Inc. ("Motorola") establishing that the infringing Android code (detailed in Oracle's Infringement

3   Contentions ("ICs")) is present on Motorola's Android devices. Google moves to exclude this

4   evidence on the primary ground that Oracle's ICs do not specifically name all of the Motorola

5   devices. Google's motion should be denied for at least three reasons:

6   *First*, as Google concedes, the Motorola Droid device *was* specifically named in Oracle's

7   ICs. With respect to that device, the Motorola evidence confirms that the infringing Android

8   code supplied by Google is installed without modification. Oracle's ICs disclosed the infringing

9   code in full detail and Oracle's expert, Dr. Mitchell, provided a complete infringement analysis in

10   his expert reports. While Dr. Mitchell did not cite the Motorola testimony in his reports and will

11   not specifically reference it at trial, there is no reason the Motorola testimony cannot be presented

12   on its own as evidence that the infringing code is installed on the Motorola Droid.

13   *Second*, as Oracle noted in its précis seeking leave to file a motion for reconsideration of

14   the Court's order striking portions of Dr. Mitchell's report, the Patent Local Rules do not require

15   the ICs to name specific third-party infringing devices to support allegations of indirect

16   infringement. With respect to Motorola devices other than the Motorola Droid, Oracle's ICs

17   disclose that "other mobile devices running Android" contain the infringing Android code

18   detailed in the ICs. The Motorola evidence confirms that infringing components of Android are

19   present on other Motorola devices. This evidence does not reveal any new infringement

20   *theories* – it is an *item of proof* showing that the accused code is installed on the third-party

21   devices. The fact that Oracle's ICs did not specifically name the other Motorola devices should

22   not preclude Oracle from offering the Motorola evidence to demonstrate Google's liability for

23   indirect infringement on account of those devices.

24   *Third*, the Motorola testimony also confirms that Motorola uses the dx tool from the

25   Android SDK to develop Android applications. As clearly disclosed in Oracle's ICs, use of the

26   dx tool infringes Oracle's '520 and '720 patents. This testimony stands on its own to demonstrate

27   that Motorola is a direct infringer of those patents, making Google an indirect infringer. Google's

28

1   motion does not address this testimony, even while asking for all Motorola testimony to be

2   excluded. There is no basis for excluding this or any of the other Motorola testimony at trial.

3   **I.   FACTS**

4   Oracle's theories of infringement regarding Android devices were fully disclosed in its

5   ICs. In both its Preliminary ICs of December 2, 2010, and the Supplemental ICs of April 1, 2011,

6   Oracle disclosed in full detail (roughly 480 pages) its theories regarding the precise Android code

7   that infringes each element of the asserted patent claims. The ICs articulated Oracle's claims

8   against Google for both direct and indirect infringement. (Declaration of Ruchika Agrawal in

9   Support of Oracle America, Inc.'s Oppositions to Google's Motions In Limine Nos. 1 Through 5

10   ("Agrawal Decl.") Ex. 5-1 at 3, 7-8 (Oracle's ICs dated April 1, 2011).) With respect to indirect

11   infringement, Oracle's ICs identified the categories of direct infringers, including manufacturers

12   of Android devices, application developers, service providers, and end users. (*Id*. at 7.) The ICs

13   specifically identified the Motorola Droid as an accused instrumentality, together with "other

14   mobile devices running Android." (*Id*. at 2.) Oracle's ICs also disclosed information

15   demonstrating that Android devices are installed with the infringing code supplied by Google.

16   (*Id*. at 3-5.) Among other things, the ICs quoted a statement from Motorola about the Motorola

17   Droid: "All Droid source consists entirely of code found at the Android repo site." (*Id*. at 4.)

18   To obtain further evidence that the infringing Android code is installed on Motorola's

19   Android devices, Oracle sought documents and testimony from Motorola. On April 12, 2011,

20   Oracle served a subpoena on Motorola requesting documents relating to Motorola's Android

21   devices. Motorola produced a single document on June 15, 2011, a log of changes that Motorola

22   had made to the Android code in general, but not necessarily to any of the infringing components

23   of Android.

24   On July 14, 2011, Oracle served a subpoena on Motorola seeking a witness under Fed. R.

25   Civ. P. 30(b)(6) to testify regarding (1) the installation of the infringing Android code on

26   Motorola's Android devices, and (2) Motorola's use of the Android dx tool to develop

27   applications. (Agrawal Decl. Ex. 5-3.) After Motorola refused to provide a witness, Oracle

28   moved to compel compliance with the subpoena on August 5, 2011. At the direction of Judge

ORACLE'S OPPOSITION TO GOOGLE'S MIL NO. 5 TO EXCLUDE EVID. OBTAINED FROM MOTOROLA MOBILITY
CASE NO. CV 10-03561 WHA
sf-3051481

2

1 Samuel Der-Yeghiayan of the Northern District of Illinois, Motorola ultimately produced a

2 witness in response to Oracle's subpoena on September 8, 2011.

3 ██

4 ██

5 ██

6 ██

7 ██

8 ██

9 ██

10 ████████████████████████████████████

11 ██

12 ██

13 **II.   ARGUMENT**

14 **A.   Oracle's ICs Specifically Identified The Motorola Droid, On Which**
   Infringing Android Code Was Installed
15

16 Oracle's ICs fully disclosed Oracle's infringement theories with respect to the Motorola

17 Droid. As Google concedes, the Motorola Droid was specifically named as an accused

18 instrumentality in Oracle's ICs. (Agrawal Decl. Ex. 5-1 [Oracle's ICs, April 1, 2011] at 2.)

19 Oracle's ICs disclosed (1) the manner in which the infringing components of Android practice the

20 asserted claims of the patents-in-suit, and (2) the fact that those infringing components are

21 installed on the Motorola Droid. (*Id.* at 5-7 [Oracle's ICs, April 1, 2011] at 3-4)

22 The Motorola testimony provides additional evidence that Motorola installed the

23 infringing Android components on the Motorola Droid. ████████████████████

24 ██

25 ████████████████████████████   While the Motorola testimony was not cited in

26 Oracle's ICs, the Patent Local Rules did not require it to be. The testimony is not the basis of a

27 new infringement *theory*, it is *evidence* that Oracle's disclosed theories are accurate (*i.e.*, that the

28 infringing Android code is installed on the Droid device). As the Court observed in its

ORACLE'S OPPOSITION TO GOOGLE'S MIL NO. 5 TO EXCLUDE EVID. OBTAINED FROM MOTOROLA MOBILITY
CASE NO. CV 10-03561 WHA
sf-3051481

3

1   September 26, 2011 Order, the Patent Local Rules "did *not* require identification of every

2   evidentiary *item of proof* showing that the accused element did in fact practice the limitation. . . .

3   That a particular document or source code file was not cited in a party's infringement disclosures

4   does not automatically preclude the party from using that document or file to support a *theory* that

5   was timely disclosed." (ECF No. 464 at 4.)

6   Google argues that the Motorola evidence was somehow obtained too late in the discovery

7   process to be used at trial. In fact, the evidence was sought and obtained within the extended fact

8   discovery period. Oracle served its document subpoena on April 12, 2011, more than four

9   months before the extended fact discovery cut-off of August 15, 2011. Oracle served its

10 deposition subpoena on July 14, 2011. Although Motorola did not provide a witness until

11 September 8, 2011 (after forcing Oracle to move to compel the testimony), the parties stipulated

12 to and the Court approved an extension of fact discovery to September 11, 2011, for the

13 completion of the Motorola deposition. (ECF No. 381.) Accordingly, the Motorola discovery

14 was completed within the extended fact discovery period. Google's counsel attended the

15 deposition, and hence Google can claim no prejudice from its timing.

16   Google also suggests that Oracle should be precluded from using the Motorola evidence

17 because Oracle's infringement expert, Dr. Mitchell, did not cite that evidence in his reports. That

18 Dr. Mitchell will not be testifying specifically regarding the Motorola testimony does not mean it

19 cannot be presented on its own as factual evidence for the jury's consideration. Oracle intends to

20 present this testimony as evidence that the infringing Android code supplied by Google was

21 installed on the Motorola Droid. There is no reason this testimony, properly obtained through the

22 discovery process, should be excluded.

23   **B.   Oracle's ICs Properly Disclosed Oracle's Indirect Infringement
                         Theories With Respect To Other Motorola Devices**

24

25   As set forth in Oracle's précis seeking leave to file a motion for reconsideration of the

26 Court's order striking portions of Dr. Mitchell's report (ECF No. 479), the Patent Local Rules do

27 not require ICs to name specific third-party infringing devices in support of allegations of indirect

28 infringement. Oracle's ICs disclosed, in detail, the infringing components of Android code, and

1 asserted that Google indirectly infringes the patents-in-suit by supplying *those same components*

2 for installation on third-party Android devices. While Oracle's ICs did not specifically list

3 Motorola devices other than the Motorola Droid, that should not preclude Oracle from asserting

4 indirect infringement against Google for supplying the infringing code.

5 Patent Local Rule 3-1 is "designed to require parties to crystallize their theories of the

6 case early in the litigation and to adhere to those theories once they have been disclosed."

7 *Network Caching Tech., LLC v. Novell, Inc.*, No. C-01-2079 VRW, 2003 U.S. Dist. LEXIS 9881,

8 at *12 (N.D. Cal. Mar. 21, 2003) (quoting *LG Elecs., Inc. v. Q-Lity Computer, Inc. v. Asustek*

9 *Computer, Inc.*, 211 F.R.D. 360, 367 (N.D. Cal. 2002)). Patent LR 3-1 does not require, however,

10 plaintiffs to "produce evidence of infringement." *Id.* That ICs are due well in advance of the

11 close of discovery is an additional reason why Patent LR 3-1 cannot require the disclosure of all

12 items of proof.

13 Patent LR 3-1(b), which applies to direct infringement, requires an identification of the

14 accused instrumentalities that is "as specific as possible." Patent LR 3-1(b). For *indirect*

15 *infringement*, Patent LR 3-1(d) requires only "an identification of any direct infringement and a

16 description of the acts of the alleged indirect infringer that contribute to or are inducing that direct

17 infringement." Patent LR 3-1(d). Patent LR 3-1(d) does not require the ICs to name specific

18 third-party infringing devices to support allegations of indirect infringement.

19 Here, Oracle's ICs extensively disclosed Oracle's theories of how the infringing

20 components of Android practice the asserted patent claims. The ICs disclosed that these

21 infringing Android components are installed on specified Android devices and "other mobile

22 devices running Android." (Agrawal Decl. Ex. 5-1 [Oracle's ICs, April 1, 2011] at 2.) The ICs

23 further stated that third parties directly infringe the asserted patent claims because they "copy,

24 sell, distribute, re-distribute, and use products that embody or incorporate" the infringing

25 components of Android. (*Id.* at 7.) In this way, Oracle clearly disclosed its theory of indirect

26 infringement.

27 The Motorola evidence is an item of proof substantiating the indirect infringement theory

28 articulated in Oracle's ICs. It does not add new theories of infringement, but supports the

ORACLE'S OPPOSITION TO GOOGLE'S MIL NO. 5 TO EXCLUDE EVID. OBTAINED FROM MOTOROLA MOBILITY
CASE NO. CV 10-03561 WHA
sf-3051481

5

1 theories already disclosed in the ICs. Accordingly, there is no basis for excluding this evidence

2 from trial.

3   **C.   Google's Motion Fails To Identity Any Reasons To Exclude Evidence
             of Motorola's Use of the DX Tool From the Android SDK**
4

5   Google's motion seeks to exclude all Motorola testimony, yet it fails to identify, or even

6 acknowledge, any reason to exclude the testimony regarding Motorola's development of Android

7 applications. Oracle's ICs disclosed its theories of infringement regarding the dx tool of the

8 Android SDK. Oracle disclosed that use of the dx tool infringes Oracle's '520 and '720 patents.

9 By supplying the dx tool in the Android SDK for use by third parties, Google is liable as an

10 indirect infringer. ████████████████████████████████████

11 ██

12 ████████████████████ Motorola's testimony stands on its own to demonstrate that Motorola

13 is a direct infringer of the '520 and '720 patents, making Google an indirect infringer of those

14 patents.

15   **III.   CONCLUSION**

16   For the reasons stated above, the Court should deny Google's motion to exclude the

17 Motorola testimony and documents from trial.

18

19 Dated: October 4, 2011   MICHAEL A. JACOBS
20   MARC DAVID PETERS
                                              DANIEL P. MUINO
21   MORRISON & FOERSTER LLP

22   By: */s/ Daniel P. Muino*
                                                   Daniel P. Muino
23
                                                   Attorneys for Plaintiff
24   ORACLE AMERICA, INC.

25

26

27

28